

### REMARKS

The Office Action dated February 28, 2002, has been carefully considered. In response thereto, the present application has been amended in a manner that is believed to place it into condition for allowance. Accordingly, reconsideration and withdrawal of the outstanding Office Action and issuance of a Notice of Allowance are respectfully requested.

Claims 1-26 are pending in the application. In the present Amendment, Applicant has amended claims 1, 7, 20 and 22, cancelled claim 6 and has added new claims 28-34 (claim 27<sup>5</sup> having been cancelled in a previous paper filed February 19, 2002).

Claim 1 was amended to incorporate the "stable support" feature of the invention recited in claim 6. Claim 6 has been cancelled. Claim 7, which previously depended on claim 6, was amended to properly depend on claim 1. Claim 20 was amended to incorporate the "spaced support" feature of the invention recited in claim 22. Claim 22 was amended to cancel the "spaced support" feature recited in that claim.

New claims 28 and 31 were added to claim a "guide rope" and "peg" which are disclosed in the specification and shown on the drawings (see page 6 and in FIGS. 1, 2 and 4 of the originally-filed application). New claims 29, 30 and 33 were added to recite the slack feature of the lower guideway and upstanding line portions of the invention which are disclosed and described in the specification and shown on the drawings (see pages 6 and 7 and FIGS. 1-3 of the originally-filed application). New claims 32 and 34 recite various combinations of features of the invention not previously claimed.

In the present Office Action, the Examiner has rejected Claims 1, 3, 4, 6-12, 16-20, 22, 25, and 26 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,138,107 to *Janis* in view of U.S. Patent No. 5,713,805 to *Scher et al.* or, in the alternative, in view of U.S. Patent No. 5,460,364 to *Ring*. For the following reasons, Applicant respectfully submits that those claims, as amended, are clearly and patentably distinguished over any one, or a combination of, the cited patent references.

First, *Janis* does not disclose “a first upstanding stable support connected to the first ends of the upper and lower guideways, and a second, spaced apart, upstanding stable support connected to the second ends of the upper and lower guideways,” as recited in amended claims 1 and 20. Indeed, *Janis* only discloses supports for the upper and lower rails 10, 12 as being a ceiling 40 and a floor 42 (see Col. 2, ll. 32-24; Col. 1, ll. 54-55: “rigid guide rails, preferably mounted to the floor and ceiling of a room”; Col. 3, ll. 5-7: “upper and lower rails 10,12 are...mounted to ceiling 40 and floor 42”; claim 1: “A tennis practice device, comprising first and second rigid guide rails mounted in parallel to upper and lower vertically spaced-apart support members respectively...”; and FIG. 1).

Although the ceiling is presumably supported by a wall, or other support structure, that wall or structure is not connected to the first and second ends of the rails. If the wall or other support structure were in fact connected to the ends of the rails, the invention in *Janis* would not work because the ball striker shown in FIG. 1 would be behind the wall or structure and unable to strike the ball 16. Further, the ball 16, after traversing the length of the apparatus after being struck, could not fully extend to the maximum horizontal position shown by the dashed line on the left side of FIG 1. Rather, the ball 16 would hit the wall without imparting potential energy to the ball-carrying member 14 and would not have enough energy to return to the striker as disclosed in the specification. Thus, *Janis* teaches away from there being a wall support attached to the ends of the rails.

Moreover, *Janis* explicitly teaches away from using upstanding supports like posts connected to the ends of the rails. Citing U.S. Patent No. 3,630,521 to *Lingbeek*, *Janis* identifies upstanding supports as inherently problematic with respect to ball game apparata and then discloses a solution to the problem (see Col. 1, ll. 10-38). Thus, it would not have been obvious to one of ordinary skill in the art to use a wall or other support connected to the ends of the rails because *Janis* teaches away from making that modification. Indeed, it is Applicant’s contribution to the art that the ball-supporting line of the present invention is connected at its terminal ends to guideways and that the ball-supporting line is substantially inelastic. Those

features, in combination with the slack in the lower guideway and an inclined upper guideway, allow the use of the invention with an upstanding support connected at the ends of the guideways because the ball can be struck so that it does not hit the opposite support, as described in the specification on page 7.

Second, *Janis* does not disclose a “generally inclined upper guideway” as recited in amended claims 1 and 20. *Janis* only discloses an apparatus connected to a horizontal ceiling and floor with “first and second parallel...rigid guide rails” (see col. 1, ll. 53-54; and claim 1: “comprising first and second rigid guide rails mounted in parallel”).

Accordingly, Applicant submits that *Janis* does not render as obvious any one of amended claims 1 or 20, or any dependent claim that depends from claims 1 and 20.

Even assuming, *arguendo*, that *Janis* does not teach away from using upstanding supports, it would not have been obvious to one of ordinary skill in the art to modify *Janis* in view of *Scher et al.* to come up with the present invention as claimed in amended claims 1 and 20. The apparatus disclosed in *Scher et al.* differs substantially from the apparatus disclosed in *Janis* and the apparatus disclosed and claimed in the present Application. In *Scher et al.*, a baseball practice device comprises a ball suspended by a “Y” shaped tether system from a yoke carried by an upstanding support. *Scher et al.* does not teach an upper and lower guideway, first and second upstanding stable supports, or slack in the lines or guideways. Thus, it would not have been obvious to one of ordinary skill in the art to combine *Janis* and *Scher et al.*

For similar reasons, it would not have been obvious to one of ordinary skill in the art to modify *Janis* in view of *Ring* to come up with the present invention as claimed in amended claims 1 and 20. The apparatus disclosed in *Ring* is similar to that disclosed in *Scher et al.* except that in *Ring* the tether from which the ball is suspended is said to be resilient. Like *Scher et al.*, *Ring* does not teach an upper and lower guideway, first and second upstanding stable supports, or slack in the lines or guideways.

The same argument is applicable to *Albert*. The practice device disclosed in *Albert* is similar to that disclosed in *Scher et al.* and in *Ring* except that in *Albert* the cord from which a

ball is suspended carries at its upper end a pulley that runs over an inclined line. Applicant submits that there is no teaching in *Albert* that suggests modifying *Janis* to come up with the claimed invention.

In sum, Applicant respectfully submits that amended claims 1 and 20 are not obvious over *Janis* alone or in combination with any of *Scher et al.*, *Ring*, *Lingbeek* and *Albert*. Since claims 2-19 depend from claim 1, and claims 21-26, 28 and 29 depend from claim 20, Applicant submits that those claims are also not obvious over *Janis* and the other cited references. Accordingly, Applicant respectfully traverses the Examiner's rejection of the pending claims and, because all of the Examiner's rejections have been addressed, requests that the Examiner's rejections of the pending claims be withdrawn and a Notice of Allowance be issued.

For similar reasons, Applicant respectfully submits that new independent claims 32 and 34 are also clearly and patentably distinguished over any one, or a combination of, the above cited patent references. For example, *Janis* does not disclose a "lower guideway that is slack when the ball is at rest," as recited in new claim 32. In fact, *Janis* discloses "rigid rails" (see col. 1, l. 54; claims 1-5; and FIGS. 1-6) and states that they are "attached" to the ceiling and floor with screws 44, which means the rails cannot be "slack" when the ball is at rest. Moreover, the elasticity of the elastic cord 14 in *Janis* prevents the cord from ever becoming slack, either when the ball is at rest or after it has been struck. In contrast, one embodiment of the present invention, as shown in FIG. 1, has a lower guideway 2 that is longer than the distance between the points where it connects to upstanding stable supports 3, 4. Thus, in that embodiment, there is slack in the guideway when the ball is at rest (see solid wavy line in FIG. 1). There is also slack in the lower portion of the upstanding line 9 (solid wavy line). After the ball is struck, the momentum in the ball can be transferred to the upstanding lines 8, 9 and also to the lower guideway 2 as the ball moves between the guideways (see dashed line in FIG. 1). In that embodiment of the invention, the upstanding lines 8, 9 are substantially inelastic so the lines become taut when the distance between the upper and lower guideways 1, 2 is greater than the slack available in the lower portion of the upstanding line and the lower guideway. At that point,

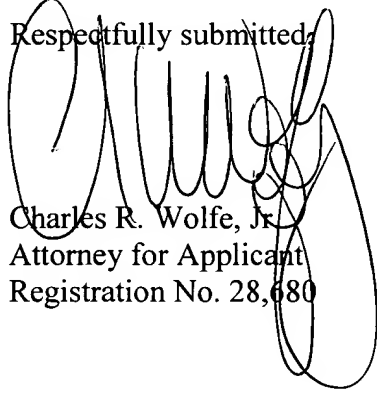
the ball stops its forward progress and begins to return towards the striker. The slack feature in one embodiment of the present invention is not taught in *Janis*.

Please charge any shortage or credit any overpayment of fees to Deposit Account No. 23-2185 (112134-00102). In the event that a petition for an extension of time is required to be submitted herewith and in the event that a separate petition does not accompany this response, the Applicant hereby petitions under 37 CFR § 1.136(a) for an extension of time for as many months as are required to render this submission timely. Any fee due is authorized above.

Finally, attached hereto is a marked-up version of the changes made to the claims by the current Amendment. The attached page is captioned "VERSION WITH MARKINGS TO SHOW CHANGES MADE."

If there are any questions relating to this amendment or the application in general, it would be appreciated if the Examiner would telephone the undersigned attorney.

Respectfully submitted,

  
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**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

**In the Claims**

-- 1 (Amended). Apparatus for use in playing and practicing ball games comprising [upper and lower guideways] generally inclined upper guideway, generally inclined or horizontal lower guideway, substantially inelastic reciprocating means connected to and freely moveable along said upper and lower guideways, [and] a ball connected to said reciprocating means, a first upstanding stable support connected to the first ends of the upper and lower guideways, and a second, spaced apart, upstanding stable support connected to the second ends of the upper and lower guideways.--

-- 7 (Amended). Apparatus according to claim [6]1 wherein the first upstanding stable support is one of a wall [or] and a pole and wherein the second upstanding stable support is one of a wall and a pole.--

-- 20 (Amended). Apparatus for use in playing and practicing ball games, comprising a ball suspended by a substantially inelastic upstanding line from an upper, generally [horizontal or] inclined elongated guideway and connected by the same or a second substantially inelastic upstanding line to a lower, generally horizontal or inclined elongated guideway, a first upstanding stable support connected to the first ends of the upper and lower guideways, and a second, spaced apart, upstanding stable support connected to the second ends of the upper and lower guideways.--

--22 (Twice Amended). Apparatus according to claim 20, wherein the upper and lower guideway comprises a string or rope [stretched between two spaced supports].--